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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,758	07/08/2005	Katsuyoshi Kondoh	12112-0006	3994
22902	7590	04/27/2007	EXAMINER	
CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			ZHU, WEIPING	
			ART UNIT	PAPER NUMBER
			1742	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/541,758	Applicant(s) KONDOH, KATSUYOSHI	
	Examiner Weiping Zhu	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 8-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/07/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

The application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.4999, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted

- I. Claims 1-7, drawn to a magnesium composite powder;
- II. Claims 8-11, drawn to a magnesium group composite material;
- III. Claim 12, drawn to a manufacturing method of magnesium composite powder; and
- IV. Claims 13-24, drawn to a manufacturing method of a magnesium group composite material.

The inventions listed as I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is the magnesium composite powder. This element cannot be a special technical feature under PCT Rules 13.2 because the element is shown in the prior art. Suzuki (US 3,957,483) discloses a magnesium composite powder, which is substantially identical to the claimed magnesium composite powder. Inventions I-II lack the same or corresponding special technical features. Therefore unity of invention is lacking and restriction is appropriate.

During a telephone conversation with Mr. Christopher W. Brody on April 16, 2007 a provisional election was made with traverse to prosecute the invention of I, claims 1-7. Affirmation of this election must be made by the applicant in replying to this Office action. Claims 8-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should the applicant traverse on the ground that the inventions are not patentably distinct, the applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

The applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 3,957,483).

With respect to claims 1, 2 and 7, Suzuki ('483) discloses a method for producing a magnesium composite having iron, zinc, chromium, aluminum and manganese attached in a finely divided form to the surface of magnesium articles by virtue of application of mechanical pressure (abstract). Suzuki ('483) further discloses that magnesium is in the form of plates, foils and particles and the terms "iron, zinc, chromium, aluminum and manganese" are defined to include their respective oxides in addition to the metals in their pure form (col. 2, lines 16-30).

Suzuki ('483) does not disclose that the finely divided component attached on the surface of magnesium particles reacts with magnesium to form a compound as claimed. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to expect that the same reaction would take place between the finely divided aluminum particles and the magnesium particles of Suzuki ('483) as the fine-grained aluminum particles and magnesium alloy coarse particles of the instant

application, because the composition of the magnesium composite of Suzuki ('483) is substantially identical to the claimed magnesium composite.

With respect to claims 3 and 4, Suzuki ('483) discloses that the magnesium particles used are not specifically limited in shape (magnesium particles of 50 mesh (353 μm) are used in example 1)) and the metals attached to said magnesium particles are required to be in a finely divided form having a particle diameter not large than 200 mesh (76 μm) (col. 2, lines 31-35). The diameter of the coarse magnesium particles disclosed by Suzuki ('483) is within the claimed range in the instant claim 3 and the range of the fine particles of Suzuki ('483) overlaps the claimed ranges in the instant claims 3 and 4. A prima facie case of obviousness exists. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to apply the claimed ranges within the disclosed range of Suzuki ('483), because Suzuki ('483) discloses the same utility over the entire disclosed range. The diameter of the coarse magnesium particles disclosed by Suzuki ('483) is close enough to the claimed range in the instant claim 4 that one of ordinary skill in the art would expect the same results. See MPEP 2144.05 I.

3. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki ('483) as applied to the claim 1 above and in view of JP 62-278201.

With respect to claims 5 and 6, Suzuki ('483) does not disclose that the fine metal particles are attached on the surfaces of the coarse magnesium particles through a binder and oil as claimed.

JP ('201) discloses a method for attaching fine metallic particles to coarse particles through a binder and oil (left col. 2nd and 3rd paragraphs, page 5, orally translated by an USPTO translator).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the fine metal particles to the surface of the coarse magnesium particles through a bind and oil in the process of Suzuki ('483) as disclosed by JP (201) in order to attach the fine metallic particles to the coarse particles uniformly as discloses by JP ('201) (right col., 1st paragraph, page 4, orally translated by an USPTO translator).

Conclusion

4. This Office action is made non-final. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WZ

4/19/2007


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